

Attorney Docket No.: **PENN-0742**
Inventors: **Zhe Lu**
Serial No.: **09/743,054**
Filing Date: **February 15, 2001**
Page 6

REMARKS

Claims 1-14 are pending in the instant application. The pending claims have been subjected to a Restriction Requirement as follows:

Group I, claims 1, 7 and 8 drawn to a tertiapin-like alpha helix compound and composition.

Group II, claim 2-4, drawn to a first method of using a tertiapin-like alpha helix compound to inhibit the activity of inward rectifier potassium channels.

Group III, claim 5 drawn to a second method of use of a tertiapin-like alpha helix compound to identify compounds.

Group IV, claim 6, drawn to a third method of use of a tertiapin-like alpha helix compound.

Group V, claim 9, drawn to a fourth method of use of a tertiapin-like alpha helix compound to control insulin secretion.

Group VI, claim 10, drawn to a fifth method of use of a tertiapin-like alpha helix compound to control cardiac rhythm and electrical conduction.

Group VII, claim 11, drawn to a sixth method of use of a tertiapin-like alpha helix compound to induce diuresis.

Attorney Docket No.: **PENN-0742**
Inventors: **Zhe Lu**
Serial No.: **09/743,054**
Filing Date: **February 15, 2001**
Page 7

Group VIII, claim 12, drawn to a seventh method of use of a tertiapin-like alpha helix compound to modulate neurotransmission.

Group IX, claims 13-14, drawn to an eighth method of use of a tertiapin-like alpha helix compound to rationally design drugs.

The Examiner suggests that the groups do not relate to a single inventive concept under PCT Rule 13.1, as under PCT Rule 13.2 they lack the same or corresponding special technical features. It is suggested that pharmaceutically active tertiapin like alpha helix compounds are known in the art, and that there is no special technical feature which links the compounds and compositions to their methods of use.

Additionally, it is suggested that the methods of Groups II through IX lack a special technical feature and further the methods address different objectives and/or utilize different protocols and method steps so as to constitute distinctly different methods. It is yet further suggested that the search of Groups I through IX represent different and separately burdensome manual/computer bibliographic search in patent and literature databases.

Applicant respectfully traverses this restriction requirement.

Attorney Docket No.: **PENN-0742**
Inventors: **Zhe Lu**
Serial No.: **09/743,054**
Filing Date: **February 15, 2001**
Page 8

All of claims of the instant application relate to the concept of inhibiting activity of inward-rectifier potassium channels using the tertiapin-like alpha helix compounds of the present invention. Accordingly, each of the claims contain the same components for use in the same endpoint, namely the use of a tertiapin-like alpha helix compound to modulate activity of inward-rectifier potassium channels. In further illustration of the relationship of the inventions, claims 5, 6, 8-12 are dependent upon Group I claims. Thus, Applicant respectfully disagrees that the Groups set forth by the Examiner are not linked to form a single general inventive concept under PCT Rule 13.1.

Further, a search of literature relating to compositions having a tertiapin-like alpha helix would clearly reveal art relating to all of these Groups. Thus, the inclusion of all Groups in this application would not be overly burdensome to the Examiner.

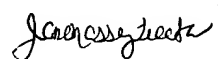
In addition, the Examiner seems to be suggesting that this invention lacks novelty over prior art as a consideration for restriction. Applicant respectfully submits that patentability over prior art should not be considered for the question of restriction. For the purposes of a decision on the question of

Attorney Docket No.: **PENN-0742**
Inventors: **Zhe Lu**
Serial No.: **09/743,054**
Filing Date: **February 15, 2001**
Page 9

restriction, claims should be assumed to be in proper format and patentable over prior art. It is only after the question of restriction is settled that the question of patentability of the several claims in view of the prior art should be addressed. Accordingly, reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested. In the event that Examiner will not withdraw the restriction between all of the groups in its entirety, Applicant respectfully requests that Group I be amended to include claims 5, 6, 8-12, as discussed above.

However, in an earnest effort to be completely responsive, Applicant elects Group I, claims 1, 7, and 8 with traverse.

Respectfully submitted,



Jane Massey Licata
Registration No. 32,257

Date: **July 7, 2004**

Licata & Tyrrell P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515